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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 09/911,142  | 07/23/2001  | Reto Sieber          | F-7086                    | 4481             |
| 7590 04/06/2004<br>JORDAN AND HAMBURG LLP<br>122 East 42nd Street<br>New York, NY 10168 |             |                      | EXAMINER<br>EGAN, BRIAN P |                  |
|   |             |                      | ART UNIT<br>1772          | PAPER NUMBER     |

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/911,142 | <b>Applicant(s)</b><br>SIEBER ET AL. |  |
|                              | <b>Examiner</b><br>Brian P. Egan     | <b>Art Unit</b><br>1772              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-34 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/9/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Double Patenting***

1. Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/311,736 in view of Stough et al. (#5,711,124). The only feature not taught by Application No. 10/311,736 is the use of perforations formed at least through the backing layer and adhesive layer wherein the central region of the tape is free of the perforations. Stough et al., however, teach the use of perforated tape for sealing joints wherein the perforations allow air caught beneath the tape in application to escape, provide a flexible substrate that allows the tape to extend into dimples and depressions surrounding studs that are in the wall while also allowing the finish coat to penetrate through the tape and fill the depressions, and allow moisture contained in the finish coat to penetrate the tape and be absorbed in the drywall panels (Col. 5, lines 4-18; Fig. 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Application No. 10/311,736 to include perforations extending through the substrate in order to improve the joint sealing process.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Objections***

2. Claim 23 is objected to because of the following informalities: the claim ends with two periods. One period should be deleted to facilitate clarity. Appropriate correction is required.
3. Claim 27 is objected to because it does not end in a period. A period should be inserted at the end of the claim to facilitate clarity. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-16 and 19-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stough et al. ('124) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307).

Stough et al. teach a pressure-sensitive tape comprising a backing layer, an adhesive layer supported by the backing layer, and a peelable protective film overlaying the adhesive layer (Col. 7, lines 61-67). The adhesive tape comprises at least two lateral longitudinal sections comprising perforations formed through the backing layer, adhesive layer, and release liner, whereby a central region of the tape is free of perforations (see Fig. 5; Col. 7, lines 30-33). The backing comprises paper (which is open-pored and exhibits adhesion properties for plaster) (Col. 7, line 63) and the adhesive layer is a pressure-sensitive acrylic adhesive (Col. 3, lines 36-37).

Although Stough et al. teaches that it is preferable to have strands of fiberglass in the cross-direction to improve tear resistance, Stough et al. teaches that it is known to only provide reinforcement in the longitudinal direction (thereby allowing the tape to be easily torn in the cross-wise direction) (Col. 3, lines 59-63) and the embodiments comprising perforations are free of fiberglass strands, thereby implicitly tearable in the cross-wise direction (see Col. 7, line 61 to Col. 8, line 30). The tape may be in roll form and is stored in a variety of dispensers (Col. 7, lines 4-5). The tape is at least 3 to 4 cm wide ("cut down to tape roll size of approximately two

inches width” – Col. 4, lines 14-15). The central region of the tape is creased to facilitate application in corner regions (Col. 7, lines 33-35), thereby forming a non-adhesive central portion. The perforations are circular and at least 3 mm in diameter (“one-eighth of an inch” – Col. 5, lines 19-20; see Fig. 5).

Stough et al. fail to teach the protective layer comprising multiple slits and the tape being folded upon itself in a transverse direction along a slit.

Hibler, however, teaches a protective tape for protecting corners wherein the protective film is slit (“scored”) along the adhesive portions of the substrate. Hibler teaches the use of slits along the protective film layer for the purpose of allowing one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner (Col. 4, lines 30-35). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made, motivated by the desire to properly adhere a tape along the corner portion of a wall, to have provided slits along the adhesive portions of the protective film layer of a tape substrate for the purpose of allowing one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner as taught by Hibler.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Stough et al. by slitting the protective film layer along each adhesive portion as taught by Hibler in order to allow one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner. Furthermore, depending on the

Art Unit: 1772

desired end product, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have provided multiple slits along the backing layer since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art, *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, and it further would have been obvious to adjust the positioning of the slit portion since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Tuoriniemi teaches a masking tape for corner structures wherein the tape is folded upon itself in a transverse direction (see Figs. 6(a-e)). Tuoriniemi teaches the rolled construction wherein the tape is folded upon itself for the purpose of allowing the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the tape to be unfolded and bonded along the other edge of the corner – thereby simplifying the application process (Col. 4, lines 46-54). Although Touriniemi do not explicitly teach the use of an intermediate layer applied along the edge of the exposed adhesive in roll form, it is notoriously well known in the adhesive art to provide exposed adhesives with protective liners. Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have provided an intermediate protective liner layer along the side of the rolled tape to protect the exposed adhesive. Furthermore, it would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have provided a roll of adhesive tape used for corner structures with a tape in a folded over relationship for the purpose of allowing the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the outer adhesive layer to be bonded along the other edge of the corner – thereby simplifying the application process – as taught by Tuoriniemi.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Stough et al. by providing the rolled tape in a folded over relationship as taught by Tuoriniemi in order allow the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the outer adhesive layer to be bonded along the other edge of the corner – thereby simplifying the application process.

6. Claims 17-18 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stough et al. ('124) in view of Hibler ('200) and Tuoriniemi ('307), and further in view of Avery (#2,373,092), Blok et al. (#6,177,163), and Samuelson (#5,736,001).

Stough et al., Hibler, and Tuoriniemi teach a roll of a pressure-sensitive adhesive tape as detailed above. The aforementioned prior art fails to teach a cardboard dispenser comprising at least one outlet slot for the tape although Stough et al. teach that the adhesive tape may be provided in a variety of dispensers. It is notoriously well known in the art, however, to provide a dispenser for tapes and/or labels in roll form as evidenced by Avery (Col. 1, lines 31-40; Col. 2, lines 52-55). Avery teaches the use of a cardboard dispenser for the purpose of allowing the roll of tape to be kept in a container that subsequently allows the tape to be dispensed from the container (Col. 1, lines 31-40). Further evidence of the notoriously well known use of dispensers for rolled tape can be found in both Samuelson (see Fig. 1) and Blok et al. (see Fig. 1). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have provided a roll of tape with a dispenser for the purpose of allowing the roll of tape to be kept in a container that subsequently allows the tape to be dispensed through the container as taught by Avery.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Stough et al. by situating the roll of pressure-sensitive tape inside a dispenser as taught by Avery in order to allow the roll of tape to be kept in a protective container that subsequently allows the tape to be dispensed through the container.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner notes that the 35 U.S.C. 112, first paragraph rejection from the previous office action has been withdrawn pursuant to the Applicant's amended claims and remarks.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 571-272-1491. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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1772

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